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09/321,387 05/27/99 HENDERSON

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WM02/1205

EXAMINER

BARNIE, R

ART UNIT

PAPER NUMBER

2643

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/321,387

Applicant(s)
HENDERSON ET AL.

Examiner
REXFORD BARNIE

Group Art Unit
2643



☒ Responsive to communication(s) filed on Oct 2, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-13 and 17-32 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 and 17-32 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo (US Pat# 5,912,956) in view of Barber et al. (US Pat# 5,251,251) or Cox, Jr et al. (US Pat# 5,655,006).

Regarding claim 1, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig.1) which stores services associated with a prepaid calling card and a voice processing system (26 of fig. 1) configure to receive a request to record a message meant for another over a network during a service setup call (see Prompts 9&11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25). Note that based on a prompt pressed, a caller can record or listen to a recorded message. Longo teaches all the claimed subject matter except suspending the recording of the at least one message when the received data indicates a prescribed period of silence.

Cox teaches an automated system and method for voice processing comprising of suspending a playback communication when a response is being made to a question or suspending recording a reply if a playback is in motion (see entire disclosure).

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Barber teaches a telecommunications network-based greeting card wherein a communication is suspended after a predetermined time limit or duration of silence has been determined (see column 5 lines 38-44).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of either Barber or Cox thus making it possible to suspend a recording session when a time limit has been reached or when a user is being prompted or when a session is in a playback mode.

Regarding claim 2, the combination of Longo and (Cox or Barber) teaches two separate entities (see fig. 1 of Longo) namely; a controller and a voice synthesizer remotely located from a calling party and from each other.

Regarding claims 3-4, The combination teaches in (108 of fig. 7, column 5 lines 50-61 and column 6 lines 26-34 of Longo) monitoring usage of a prepaid account.

Regarding claims 5-8, see the explanation as set forth in the rejection of claim 1. Furthermore, the combination teaches in (see fig. 3 of Longo) a PIN unique to a cardholder. Note that based on a prompt pressed, a caller can record or listen to a recorded message.

3. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo (US Pat# 5,912,956) in view of Atkins et al. (US Pat# 5,487,107).

Regarding claim 9, see the explanation as set forth in the rejection of claim 1. It can be said that based on Longo's teaching, that if one has an account which makes it possible to store a message in conjunction with a prepaid account and can be used in making calls, one can do so

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accordingly. Longo fails to teach instructing a caller to contact a customer service center if a requested service can not be provided.

It's well known in the art to inform a user to contact a customer service center if a requested service can not be provided based on authentication information used in determining if a customer has subscribed the requested service or made pre-arrangements with a service provider.

Atkins teaches a method and apparatus for processing telephone calls charged to debit cards and so forth wherein a user could be given the telephone number for customer service (see column 6 lines 34-36) if authentication for a requested service was unable to be performed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Atkins into that of Longo thus informing users to contact customer service during authentication of a requested service if a requested task is unable to be performed due to inaccurate information or a caller not being eligible for the service because he/she has not subscribed to the requested service.

Regarding claims 10-12, the combination teaches debiting a prepaid account based on usage (see Longo). Furthermore, it's well known to designate a prepaid account in terms of minutes, money and so forth.

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Longo (US Pat# 5,912,956) in view of Atkins et al. (US Pat# 5,487,107) and further in view of Kamel (US Pat 6,009,150).

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Regarding claim 13, The combination fails to teach the claimed subject matter but Kamel teaches a call processing method for delivering promotional messages wherein messages can automatically be relayed to a user given that a PIN is verified and valid or automatically inserting messages during a call as being well known (see entire disclosure).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Kamel into the combination thus making it possible to automatically deliver messages.

5. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo (US Pat# 5,912,956) in view of Barber et al. (US Pat# 5,251,251).

Regarding claim 17, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig.1) which stores services associated with a prepaid calling card and a voice processing system (26 of fig. 1) configure to receive a request to record a message meant for another over a network during a service setup call (see Prompts 9&11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25). Note that based on a prompt pressed, a caller can record or listen to a recorded message. Longo fails to teach the possibility of deleting a message after a playback of the message.

Barber teaches a telecommunications network-Based greeting card method and system



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wherein one can record a message and deleting the message after a play out or back (see fig. 3(a) and column 6 lines 51-22) wherein the call could be a calling card call when the recording is made.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Barber into that of Longo thus making it possible to save memory space by deleting messages already listened to.

Regarding claim 18, the combination of Longo and Barber teaches the claimed subject matter (see fig. 1 of Longo).

6. Claims 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo (US Pat# 5,912,956) in view of Barber et al. (US Pat# 5,251,251) and further in view of Walker et al. (US Pat# 5,825,863).

Regarding claims 19-20, The combination fails to teach that a prepaid account which can be expressed in terms of units or minutes and so forth but Walker teaches a prepaid limited usage calling card comprising of a dat storage means (24, 26 and 28 of fig. 1) wherein a plurality of services as desired by a subscriber can be stored comprising of setting time limits, call forwarding and so forth. A voice messaging system (see 25 of fig. 1) can be used in recording messages for called parties during a service setup call using a prepaid card if a called party happens to be busy with for instance another call (see column 7 lines 3-12). Walker teaches in (fig. 1 and column 4 lines 38-61) that a balance account can be in terms of monetary value or call unit time. A voice

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messaging system is located remotely from a prepaid account database. Note that a prepaid account can be used in making any call as long as there is sufficient funds.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Walker into that of the combination thus making it possible to debit an account which is stored in terms of units or time based on telephone usage and thus to avoid fraudulent usage of depleted accounts.

Regarding claims 21-24, The combination Longo and Barber teaches that a calling party can be prompt to activate prompt 9 if he/she wants to automatically hear a message associated with a card identifier as recorded by a subscriber/user (see 108 of fig. 7 of Longo).

7. Claims 25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al, in view of Nabkel (US Pat# 5,963,626) or Taskett (US Pat# 5,923,734).

Regarding claim 25, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig.1) which stores services associated with a prepaid calling card and a voice processing system (26 of fig. 1) configure to receive a request to record a message meant for another over a network during a service setup call (see Prompts 9&11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25). Note that based on a prompt pressed, a caller can record or listen to a recorded message. Eventhough, Longo teaches the possibility of listening to a recorded message, one has to manual request to listen to a stored message. Thus, Longo fails to teach automatically relaying a stored message to a caller during an access call. Taskett teaches a method and apparatus

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wherein during an access call, a message or voice indicia stored in conjunction with a prepaid account is relayed automatically to the caller (see column 2 lines 56-64 and column 5 lines 14-45).

Nabkel teaches a method and system for posting messages to callers based on caller's identity which could comprise of ANI and a PIN wherein stored messages meant for the callers can be relayed as such (see fig. 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Taskett or Nabkel into that of Longo thus making it possible to automatically relay information to caller based on identifiers associated with the calling party without having to manually request stored messages which saves users time and important messages can be automatically relayed to callers so that necessary responses/actions could be taken.

Regarding claim 27, see the explanation as set forth in the rejection of claim 25.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al, in view of Nabkel (US Pat# 5,963,626) or Taskett (US Pat# 5,923,734) in view of Walker et al. (US Pat# 5,825,863).

Regarding claim 26, The combination fails to teach the claimed subject matter but Walker teaches a prepaid limited usage calling card comprising of a data storage means (24, 26 and 28 of fig. 1) wherein a plurality of services as desired by a subscriber can be stored comprising of setting time limits, call forwarding and so forth. A voice messaging system (see 25 of fig. 1) can be used in recording messages for called parties during a service setup call using a prepaid card if

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a called party happens to be busy with for instance another call (see column 7 lines 3-12). Walker teaches in (fig. 1 and column 4 lines 38-61) that a balance account can be in terms of monetary value or call unit time. A voice messaging system is located remotely from a prepaid account database. Note that a prepaid account can be used in making any call as long as there is sufficient funds.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Walker into that of the combination thus making it possible to debit an account which is stored in terms of units or time based on telephone usage and thus to avoid fraudulent usage of depleted accounts.

9. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo et al. (US Pat# 5,912,956).

Regarding claim 28, Longo teaches a communication system for recording at least one message associated with a pre-paid card comprising of a data storage system (see 24 of fig.1) which stores services associated with a prepaid calling card and a voice processing system (26 of fig. 1) configure to receive a request to record a message meant for another over a network during a service setup call (see Prompts 9&11 of fig. 7, fig. 9, column 4 lines 42-44, and column 6 lines 18-25). Longo teaches an account wherein one can record messages in conjunction with a prepaid account, recharge the account and so forth thus making the prepaid calling card or system taught by Longo a 'special card or system' with a variety of features.

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The examiner takes official notice that usage of prepaid calling cards solely meant for making telephone calls and nothing else is well known in the art. After the account is depleted, one can then dispose of the card. Card such as Econo, Global connect and so forth are some of the cards which are used in making telephone calls.

Thus, it would have obvious to one of ordinary skill in the art at the time the invention was made that depending on the available services of a service provider, prepaid card issuer, prepaid card being used, customer subscribed services and so forth one might/might not be eligible for a plurality of services such as recharging one's card and so forth thus making the card only eligible for making calls, a fact notoriously well known in the art.

Regarding claim 29, see the explanation as set forth in the rejection of claim 28. If the card is used solely as calling card then the user is prompted with a message to input the number of the called party, well known in the art, which is unafflicted with the prepaid calling card.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Longo in view of Nabkel (US Pat# 5,963,626).

Regarding claim 30, Longo teaches all the claimed subject matter except deleting a stored messages after it's been played back a number of times. However, Nabkel teaches a method and system for posting messages to callers wherein a message can expire after it's been played back to a number of people in a list (see column 3 lines 34-42).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Nabkel into that of Longo thus making it possible to delete or erase a message after it's been listen to by a designated group.

11. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longo in view of Moen (US Pat# 5,592,537).

Regarding claims 31-32, Longo teaches a prepaid calling card wherein one can record any desired message in conjunction with the card which can be listened during an access call and fails to put a restriction on what message can be recorded. Longo fails to teach the possibility of recording messages related to purchase preference) but Moen teaches a method of providing message service for limited access telecommunications wherein a plurality of messages can be stored in conjunction with a prepaid account (see entire disclosure). Please, not mark

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of Longo and Moen *to record any desired message in conjunction with a prepaid account for a subsequent playback.*

Response to Arguments

12. Applicant's arguments with respect to claims 1-13 and 17-32 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **REXFORD BARNIE** whose telephone number is (703) 306-2744. The examiner can normally be reached on Monday through Friday from 8:30 to 6:00p:m

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708. The **informal fax number** (Draft or Proposed Amendment) **formal fax number** for the group is (703) 308-9051 or 308-9052. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 305-3900. **R.B. 11/27/00.**


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